

### Remarks

The July 24, 2008 Official Action has been carefully reviewed. In view of the amendments submitted herewith and the following remarks, favorable reconsideration and allowance of this application are respectfully requested. The present remarks and amendments are being filed as part of the submission required under 37 C.F.R. §1.114, in connection with the Request for Continued Examination, which is submitted concurrently herewith.

At the outset it is noted that a shortened statutory response period of three (3) months was set forth in the July 24, 2008 Official Action. Therefore, the initial due date for response was October 24, 2008. A petition for a three month extension of the response period is presented with this response, which is being filed within the three month extension period.

The Examiner has rejected claims 1 and 4-6 under 35 U.S.C. §102(b) as allegedly being anticipated by WO 02/058450.

The Examiner has also rejected claims 1, 4, and 6 under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent 6,548,643.

Lastly, the Examiner has objected to claims 5 and 6 under 37 CFR §1.75 as allegedly being a substantial duplicate of claim 5. The Examiner has also objected to claim 5 for allegedly being dependent upon a rejected base claim.

The foregoing objections and rejections constitute all of the grounds set forth in the July 24, 2008 Official Action for refusing the present application.

In accordance with the instant amendment, claim 5 has been rewritten in independent form, claim 6 has been amended to depend from claim 5, and claims 1 and 8 have been amended to exclude SEQ ID NO: 34. Applicants note that a member of the groups recited in amended claims 1 and 8 has been deleted. Applicants respectfully submit that these amendments do not introduce new matter. Indeed, the MPEP at §2713.05(i) states:

Any negative limitation or exclusionary proviso must have

basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See In re Johnson, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) ("[the] specification, having described the whole, necessarily described the part remaining.").

Further, the United States Court of Customs and Patent Appeals (CCPA) stated in In re Johnson that the Applicants were "merely excising the invention of another, to which they are not entitled, and are not creating an "artificial subgenus" or claiming "new matter." *Id.* The CCPA also stated in In re Driscoll that when a class of chemical compounds is described in terms of a structural formula and the substituents are defined as a Markush group, then the inventor has asserted "the members of the Markush group ... are alternatively usable for the purposes of the invention." In re Driscoll, 562 F.2d 1245, 1249 (CCPA 1977). In view of all of the foregoing, it is clear that the deletion of a member of a group is permissible under the requirements of 35 U.S.C. §112, first paragraph.

No new matter has been introduced into this application by reason of any of the amendments presented herewith.

In view of the present amendment and the reasons set forth in this response, Applicants respectfully submit that the above objections and the 35 U.S.C. §102(b) rejections, as set forth in the July 24, 2008 Official Action, cannot be maintained. These grounds of rejection and objection are, therefore, respectfully traversed.

#### **STATEMENT OF SUBSTANCE OF INTERVIEW**

This Statement of Substance of Interview is being submitted in accordance with §713.04 of the Manual of Patent Examining Procedure to make of record a telephone interview held between Examiner Misook Yu and the undersigned on or about August 1, 2008. The Interview Summary Form dated August 6, 2008 indicated that a written reply to the last Official

Action must include the Statement of Substance of Interview.

A telephonic interview was held on or about August 1, 2008 between the undersigned and Examiner Yu for the purpose of discussing the status of the claims in the July 24, 2008 Official Action. More specifically, the undersigned informed Examiner Yu that the July 24, 2008 Official Action was confusing with regard to the status of certain claims. Indeed, the Office Action Summary indicates that claims 5 and 6 are objected to, but claim 5 has been rejected under "35 USC 10(b)" at page 2 of the Official Action, which should obviously recite 35 U.S.C. §102(b). Further, at page 4 of the Official Action, claim 5 has been objected to for being a substantial duplicate of itself and claim 6 has been objected to for being a substantial duplicate of claim 5, even though claims 5 and 6 are clearly drawn to different subject matter. Examiner Yu acknowledged the errors in the July 24, 2008 Official Action and indicated that claim 7 has been objected to for allegedly being a substantial duplicate of claim 5 and only claims 1, 4, and 8 have been rejected under 35 U.S.C. §102(b).

This Statement of Substance of Interview is being filed with the reply to the last Official Action in accordance §713.04 of the MPEP.

**THE CLAIMS ARE NOT ANTICIPATED BY THE '450 APPLICATION**

The Examiner has rejected claims 1, 4, and 8 under 35 U.S.C. §102(b) as allegedly being anticipated by the '450 application. Specifically, the Examiner contends that the peptide presented in Figure 14B of the '450 application is identical to SEQ ID NO: 24 of the instant invention. Applicants respectfully disagree with the Examiner's position.

At the outset, claim 8 does not recite SEQ ID NO: 24. Accordingly the rejection of this claim is untenable. With regard to claims 1 and 4, Applicants respectfully submit that the peptide provided in Figure 14B of the '450 application is not SEQ ID NO: 24 of the instant application.

Indeed, the sequence provided in Figure 14B of the '450 application is:

Pro-Ser-Ser-Thr-Asp-Arg-Ser-Pro,  
whereas SEQ ID NO: 24 of the instant application is:

Pro-Ser-Ser-Thr-Asp-Arg-Ser-Pro-Tyr.

Inasmuch as the '450 application fails to teach and every element of the instantly claimed invention, the rejection of claims 1, 4, and 8 under 35 U.S.C. §102(b) is untenable. Withdrawal of the rejection is respectfully requested.

#### **THE CLAIMS ARE NOT ANTICIPATED BY THE '643 PATENT**

The Examiner has rejected claims 1, 4, and 8 under 35 U.S.C. §102(b) as allegedly being anticipated by the '643 patent. It is the Examiner's position that SEQ ID NO: 28 of the '643 patent is identical to SEQ ID NO: 34 of the instant application.

Applicants respectfully disagree with the Examiner's position. However, in the sole interest of expediting prosecution of the instant application, Applicants have deleted SEQ ID NO: 34 from the instant claims.

Accordingly, the instant rejection of claims 1, 4, and 8 under 35 U.S.C. §102(b) cannot be reasonably maintained. Withdrawal of the rejection is respectfully requested.

#### **CLAIM OBJECTIONS**

The Examiner has objected to claims 5-7 on two grounds. First, the Examiner has objected to claims 5 and 6 for being dependent on a rejected base claim. The Examiner has indicated that these claims would be allowable if rewritten in independent form. In accordance with the instant amendment, claim 5 has been rewritten in independent form and claim 6 has been amended to depend from claim 5. Accordingly, the objection of claims 5 and 6 has been overcome and Applicants respectfully request the objection be withdrawn.

Second, the Examiner has objected to claim 7 for

being a substantial duplicate of claim 5. Applicants respectfully disagree with the Examiner's position. Claim 5 recites a composition comprising an isolated MUC1 cytoplasmic tail peptide, wherein the sequence of the MUC1 cytoplasmic tail peptide is selected from the group consisting of SEQ ID NO: 47, SEQ ID NO: 48, and SEQ ID NO: 49. Accordingly, a composition comprising any one of SEQ ID NO: 47, SEQ ID NO: 48, and SEQ ID NO: 49 is encompassed by claim 5. In stark contrast, claim 7 recites a composition comprising "the MUC1 cytoplasmic tail peptide of SEQ ID NO: 47, the MUC1 cytoplasmic tail peptide of SEQ ID NO: 48, and the MUC1 cytoplasmic tail peptide of SEQ ID NO: 49." Accordingly, claim 7 requires that the composition comprise three peptides, namely SEQ ID NO: 47, SEQ ID NO: 48, and SEQ ID NO: 49. It is without question that the claims are drawn to different subject matter. As such, the instant objection under 37 CFR §1.75 is untenable and Applicants respectfully request its withdrawal.

#### CONCLUSION

In view of the amendments presented herewith, and the foregoing remarks, it is respectfully urged that the rejections and objections set forth in the July 24, 2008 Official Action be withdrawn and that this application be passed to issue.

In the event the Examiner is not persuaded as to the allowability of any claim, and it appears that any outstanding issues may be resolved through a telephone interview, the Examiner is requested to call the undersigned at the phone number given below.

Respectfully submitted,  
DANN, DORFMAN, HERRELL AND SKILLMAN  
A Professional Corporation

By   
Robert C. Netter, Jr., Ph.D., J.D.  
PTO Registration No. 56,422

Telephone: (215) 563-4100  
Facsimile: (215) 563-4044